

REMARKS

Status of the Claims

Claims 1-12 and 19-36 are pending

Claims 1-12 and 19-35 currently stand rejected.

I. Amendments

Claims 1-6, 19-20, 23-24 and 35 have been amended to more particularly point out what the applicant considers their invention. The amendments to the claims are supported throughout the specification. The amended claims do not contain any new matter.

II. New Claims

New claim 36 has been added. No new matter is introduced with the new claim that is not supported by the specification.

III. Claim rejections under 35 U.S.C. 103

Claims 1-12 and 19-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lutz et al. (USPN 6,475,104) for disclosing a thread winding layer disposed over a center. Applicants respectfully requests that the rejection be removed as it does not teach the claimed

invention without resorting to hindsight reasoning based upon the Applicants' own specification. The Lutz et al patent does not anticipate, nor does it claim the Applicants' claimed invention. Lutz et al issued on November 5, 2002, which is after the Applicants' filing date of July 27, 2001 and thus no statutory bar exists.

Applicants enclose a new Rule 131 declaration signed by Sanjay Kuttappa, Jens John and John Calabria. All inventors have signed the new declaration. As evidence that the actual reduction to practice of the Applicants' claimed invention was before February 4, 2000, the effective 102(e) date of the Lutz patent, the inventors include an exhibit referring to the production and testing of an optimal golf ball for production and not experimentation of the concept. Examples with the claimed threads were produced well prior to the date of this exhibit.

Mr. Kuttappa and John Calabria have intimate knowledge of the enclosed exhibit and subject matter. The declaration includes a one page exhibit provides sufficient proof of an actual reduction to practice of the claimed invention prior to the filing date of Lutz. This effectively removes the Lutz et al patent from consideration as prior art because the Applicants' actual reduction to practice was before the effective 102(e) date of the Lutz et al patent.

Additionally, the rejection of claims 1-12 and 19-22 by Lutz is improper because it fails to teach each and every element of the reject claims. The examiner improperly applies the teaching of the Applicants own specification using hindsight reasoning and transfers it into the Lutz reference, which teaches that the filler is placed into the thread layer and not into the thread as claimed. Furthermore, the Lutz reference is completely silent regarding thread specific gravity or thread layer specific gravity, which is specifically claimed by the Applicants. The example for the thread given is polyisoprene that is known to have a specific gravity of 0.95 and not the Applicant's claimed requirement of 1.2.

The complete teaching of Lutz specification that the examiner has cited at column 8, lines 46-65 is reproduced below:

Fillers may be used to adjust the density, elastic modulus, mold release, and/or melt flow index of any layer of the golf ball, **although preferably fillers are used to adjust the density of the impregnated wound layer.** A density adjusting filler may be used to control the moment of inertia, and thus the initial spin rate of the ball and spin decay. For example, fillers may be present in an amount from 0 up to about 200 phr based on 100 phr of the impregnation material. **A density adjusting filler according to the invention preferably is a filler that has a**

specific gravity of at least about 0.05 and more preferably at least about 0.5 higher or lower than the specific gravity of the impregnation material. Particularly preferred density adjusting fillers have specific gravities that are higher than the specific gravity of the resin composition by about 0.2 or more, more preferably by about 2 or more. **The density-adjusting fillers for use in the invention preferably have a specific gravity in the range of about 0.6 to 20.** These density-adjusting fillers may also incidentally modify the elastic modulus or mold release properties of the material to which they are added. (emphasis added)

Lutz teaches that "[f]illers may be used to adjust the density . . . of any layer of the golf ball." However, the Applicants claim the specific gravity of the thread as 1.2 and not the layer. Regardless, Lutz does not teach the specific gravity of the layer and it is thus improper to state that it does. The "density-adjusting fillers" of Lutz are added to the **impregnation material** or thread layer by a liquid coating process that fills the voids and thus it is the Lutz reference that does not have any specific gravity requirements for fillers or threads, and not the Applicant's specification.

Lutz's filling of the voids in the windings with material other than the cover completely changes the golf ball's characteristics and playability that removes a majority of the benefits of improved feel with a thread

wound ball but retains the high processing costs. The use of low gravity fillers taught by Lutz destroys the properties of the thread if included to make a specific gravity of 1.2.

The Applicants have amended claim 1 and 2-12 through their dependency to clarify that the thread is compounded in addition to having a specific gravity of 1.2. The examiner is correct on page 5 of the September 10, 2003 office action that the "thread layer" example of table 2 has a specific gravity of 0.777, which is completely different from the claimed at least one thread's specific gravity. To increase of the moment of inertia of the ball without filling in the voids in the windings layer requires a higher specific gravity thread and it clearly states this in the Applicants' specification and thus it is not "a design choice" because the applicant does disclose a critical need for such a value.

The Applicant's specification on page 9, line 11, teaches that the specific gravity of the thread layer, not the thread used to make the layer, has a specific gravity of 0.7 to 1.25. The thread is disclosed to have a specific gravity greater than 1.2 at page 7, line 8. The voids in the thread layer of the Applicant's claimed ball are filled

with the cover material that is later disposed over the threads.

The voids in Lutz's ball are filled with a liquid penetrant that contains any filler of a specific gravity above that of the thread used and the liquid is cured before the application of the cover. The Lutz ball acts and feels more like a two-piece ball because of the filling in of the voids with a material other than the cover, thus defeating the purpose of a wound ball.

The Lutz specification teaches this throughout the body of the patent as at column 9, lines 16-23:

*For example, using a density-adjusting filler **having a higher density than the impregnation material**, golf balls can be prepared according to the present invention **having a high density wound layer having higher resilience than conventional wound layers**. Using a high density liquid material can decrease the density requirement of the center of the ball about which the impregnation material is disposed. This consequently adjusts the moment of inertia. (emphasis added)*

The amended claims now require that the thread must be compounded, which results in a uniform specific gravity throughout the thread, that is clearly not taught in the Lutz ball that shows only a partial penetration of the liquid.

Lutz fails to teach each and every required limitation of the rejected claims. Furthermore, the argument of lack of criticality of a specific gravity of 1.2 for the thread is not a legitimate method to produce a prima facie case of obviousness required by the law. Furthermore, this statement is not supported by the specification that clearly discusses the criticality of using a minimum specific gravity of 1.2 in the thread.

The enclosed Rule 131 declaration, signed by all inventors, is now sufficient for the removal of Lutz et al as prior art. The Applicants respectfully request the reconsideration of the obviousness rejection and allowance of claims 1-12 and 19-22.

Claims 23-25, 27-28 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lutz et al '104 in view of Kakiuchi et al (USPN 5,846,142). The rejection is now considered moot by the Applicants as discussed above in light of the enclosed Rule 131 affidavit enclosed. This declaration should remove effectively the Lutz patent as a prior art reference.

Regardless of the sufficiency of the declaration the combination does not teach each and every element of the rejected claims. Independent claim 23 has been amended to more particularly point out what the Applicants consider to be their invention. Claim 23 as now amended, and claims that depend thereupon, are not taught by the cited combination of references. The combination fails to teach using high specific gravity fillers within the body of the thread.

Kakiuchi et al teaches the use of addition of only low gravity fillers to the threads as correctly stated by the examiner. Kakiuchi et al when considered singly fails to teach each and every required limitation of claims 23-25, 27-28 and 33. Thus a prima facie case of obviousness is not produced with the use of Kakiuchi et al alone or in combination with Lutz. Applicants respectfully request reconsideration and removal of the obviousness rejection of claims 23-25, 27-28 and 33.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lutz et al `104 in view of Kakiuchi et al `142 further in view of Umezawa et al `885. As discussed above this rejection should be considered moot in light of the enclosed Rule 131 affidavit from the Applicants and that declaration should effectively remove Lutz et al from consideration as prior art.

Regardless, in light of the amendment to claim 23, the cited combination of Lutz with Kakiuchi et al `142 further in view of Umezawa et al `885, either singly or in combination fails to teach each and every element of claim 26. Applicants respectfully requests reconsideration and removal of the obviousness rejection of claim 26.

Claims 29-32 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lutz et al `104 in view of Kakiuchi et al `142 and Applicants admission. Applicants disagree that any admissions have been made in the specification regarding the prior art as alleged by the examiner. Regardless of this point of contention, the rejection of claims 29-32 and 34-35 is moot in light of the enclosed Rule 131 affidavit as discussed above that should remove the Lutz patent as a reference. In addition claim 23 has been amended to more particularly point out the invention.

The Kakiuchi et al `142 patent does not disclose threads having high specific gravity fillers as properly

stated by the examiner. The Kakiuchi et al `142 patent when used singly or when in combination with the Applicants' alleged admission fails to teach each and every required limitation of claims 29-32 and 34-35. Applicants respectfully request reconsideration and removal of the obviousness rejections of claims 29-32 and 34-35.

IV. Double Patenting Rejection

Claims 1-12 and 19-35 are rejected under obviousness type double patenting over claims 1-14 of US Patent No. 6,270,428. The `428 patent specifically limits heavy fillers to the core in two-piece balls and the center of a three-piece ball. The Applicants request that the examiner review the `428 patent specification. The Applicants respectfully request reconsideration and removal of this rejection because the `428 patent is not related and does not share any common features. It is well founded in patent law that the claims of a patent must be interpreted in light of the specification. The examiners statement ``a center and a thread layer creating a core could be interpreted to mean that a heavy filler is found in a thread layer'' is contrary to the plain meaning of the claims and teaching of the specification of the `428 patent.

The inventions are not obvious or related other than both being directed towards a thread wound ball. The claims of the `428 patent and the instant inventions specification

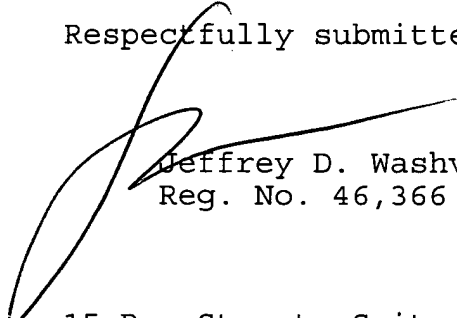
are not obvious since they are directed toward completely different inventions. Therefore the examiner's double patenting obviousness rejection is respectfully requested to be reconsidered in light of the completely contrary teachings of the '428 patent with respect to the applicants specification and claims.

V. Conclusion

The applicants respectfully request reconsideration and removal of all rejections of claims 1-12 and 19-35 that are clearly patentable over the prior art combinations.

Please feel free to call collect with any questions regarding this submission or any matters relating to this application.

Respectfully submitted,



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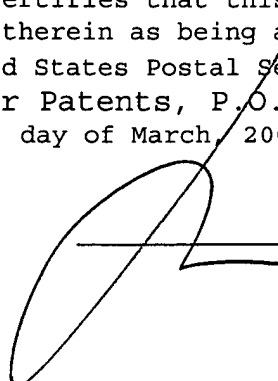
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ENCLOSURE: Rule 1.131 declaration

Certificate of Mailing under 1.8

The undersigned hereby certifies that this paper along with any paper or document referred to therein as being attached or enclosed, is being deposited with the United States Postal Service to the Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450- This 10th day of March, 2004.



Jeffrey D. Washville